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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,592	04/09/2004	Mark D. Levitt	117-P-1345USD3	1562
23322	7590	10/05/2004	EXAMINER	
IPLM GROUP, P.A. POST OFFICE BOX 18455 MINNEAPOLIS, MN 55418			AHMED, SHEEBA	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/821,592

Applicant(s)

LEVITT ET AL.

Examiner

Sheeba Ahmed

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27,36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27,36 and 37 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/9/04; 9/9/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Preliminary Amendment

1. The preliminary amendment submitted in the above-identified application has been entered. Claims 28-35 have been cancelled. New claims 36 and 37 have been added. **Claims 1-27, 36, and 37 are now pending.**

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-19 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamrock et al. (WO 98/11168).

Hamrock et al. disclose a floor finishing system comprising a radiation curable composition and a primer composition wherein the primer composition is coatable over a substrate and the radiation curable composition is coatable thereon (Page 6, lines 25-30). The radiation curable coating comprises a polyfunctional isocyanurate and a hydroxyalkyl acrylate (Page 4, lines 21-30). A preferred monomer is shown on Page 5 and contains an aromatic group (*thus meeting the limitations that the topcoat composition comprises an acrylated urethane or an aromatic urethane*). The cured, coatable composition is readily strippable from the substrate when the latex primer is present (Page 7, lines 1-3). In applying the coating compositions of the

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invention to a suitable substrate, it is preferred that the composition be applied in a manner which creates a coating no greater than about 1.3 mm in thickness (Page 18, lines 29-31). With regards to the stripability rating limitations recited in claim 16, the Examiner takes the position that such property limitations must be inherently present in the coatings taught by Hamrock et al. given that the chemical composition of the coatings and the structure of the laminate as taught by Hamrock et al. and as claimed in the instant application is identical. All limitations of the claimed invention are either disclosed or inherent in the above reference.

3. Claims 20, 22-24, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Bolgiano et al. (US 4,421,782).

Bolgiano et al. disclose flooring materials and a process for making such flooring materials whereby a substrate (***corresponding to the intermediate coating of the claimed invention***) is treated with a solution comprising water, acrylic acid and a surfactant (***corresponding to the topcoat of the claimed invention and meeting the limitations that the topcoat is UV curable and comprises an acrylate***). Upon irradiating the treated substrate, a tough and durable surface is formed (Column 2, lines 16-23). The substrate may be treated while on an intermediate support surface or when in place on a finished product (Column 3, lines 5-12). The aqueous acrylic acid solution comprises 0.1 to about 75 percent by weight of acrylic acid and from about 0.01 to about 5 percent by weight of a surfactant (Column 3, lines 48-51). The coatings are curable by UV irradiation (see Examples). Example II states that the coatings were

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applied to a vinyl-flooring tile. All limitations of claims 20, 22-24, and 27 are either inherent or disclosed in the above reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bolgiano et al. (US 4,421,782) in view of Koreltz et al. (WO 94/22965).

Bolgiano et al., as discussed above, do not state that their floor finishing system further comprises a strip agent.

However, Koreltz et al. disclose compositions used to strip coatings such as floor finishes and/or greasy residues from surfaces such as floors and the composition is effective in removing multiple coatings comprising urethane/acrylic polymers (Page 1, lines 5-9 and Page 3, lines 35-37).

Accordingly, it would have been obvious to one having ordinary skill in the art to add the strip composition disclosed by Koreltz et al. to the floor finishing system disclosed by Bolgiano et al. given that such compositions can be used to remove multiple coatings comprising urethane/acrylic polymers.

5. Claims 20, 22-27 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamrock et al. (WO 98/11168) in view of Holman et al. (US 6,444,134 B1).

Hamrock et al. disclose a floor finishing system (***corresponding to the strippable laminate finish kit of the claimed invention***) comprising a radiation curable composition and a primer composition (***corresponding to the intermediate coating of the claimed invention***) wherein the primer composition is coatable over a substrate and the radiation curable composition (***corresponding to the topcoat of the claimed invention***) is coatable thereon (Page 6, lines 25-30). The radiation curable coating comprises a polyfunctional isocyanurate and a hydroxyalkyl acrylate (Page 4, lines 21-30). A preferred monomer is shown on Page 5 and contains an aromatic group (***thus meeting the limitations that the topcoat composition comprises an acrylated urethane or an aromatic urethane***). The cured, coatable composition is readily strippable from the substrate when the latex primer is present (Page 7, lines 1-3).

Hamrock et al. do not specifically teach that the radiation curable coating (*i.e., the coating corresponding to the top of the claimed invention*) is water borne or that it comprises water.

However, Holman et al. disclose a method of finishing floors wherein the floor may be coated with a water based finish including urethane and acrylic polymers and copolymers and crosslinking agents (Column 2, lines 1, lines 5-6 and Column 2, lines 3-5). Examples of the polymers include aliphatic urethanes, urethane/acrylic polymers and

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acrylic polymers and these polymers/copolymers are designed for high performance uses, where hardness, flexibility, UV resistance, chemical resistance and abrasion resistance are desired. One specific example of the urethane/acrylic copolymer is a high solids, radiation curable, water-borne formulation by the trade name of NEORAD 3709 (Column 4, lines 11-36). Preferably, the coating compositions have a solids content of 30-70 wt.% based on the total weight of the composition (Column 4, lines 1-5).

Accordingly, it would have been obvious to one having ordinary skill in the art to replace the radiation curable coating comprising a polyfunctional isocyanurate and a hydroxyalkyl acrylate, as taught by Hamrock et al., with a water based finish including urethane and acrylic polymers and copolymers and crosslinking agents given that Holman et al. specifically teach that such water-borne coatings exhibit high hardness, flexibility, UV resistance, chemical resistance and abrasion resistance. With regards to the limitation that the polymerized topcoat can be at least partially stripped from the tile in 30 minutes and that the intermediate coating has a stripability rating of 6 or more on a 7 point scale and that the topcoat has a stripability of 4 on a 7 point scale, the Examiner takes the position that such limitations must be met by the coatings taught by Hamrock and Holman given that the chemical composition of these coating and that of the claimed invention are identical.

6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hamrock et al. (WO 98/11168) in view of Holman et al. (US 6,444,134 B1) and Koreltz et al. (WO 94/22965).

Hamrock et al. and Holman et al., as discussed above, do not teach that the floor finishing system (***corresponding to the strippable laminate finish kit of the claimed invention***) further comprises a strip agent.

However, Koreltz et al. disclose compositions used to strip coatings such as floor finishes and/or greasy residues from surfaces such as floors and the composition is effective in removing multiple coatings comprising urethane/acrylic polymers (Page 1, lines 5-9 and Page 3, lines 35-37).

Accordingly, it would have been obvious to one having ordinary skill in the art to add the strip composition disclosed by Koreltz et al. to the floor finishing system disclosed by Hamrock et al. given that such compositions can be used to remove multiple coatings comprising urethane/acrylic polymers.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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7. Claims 20-27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20-27 and 41-51 of copending Application No. 09/560,170. Although the conflicting claims are not identical, they are not patentably distinct from each other because the additional limitations recited in claims 20-27 and 41-51 of copending Application No. 09/560,170 are inherent in the laminate finish kit of the instantly claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.


Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (571)272-1504. The examiner can normally be reached on Mondays and Thursdays from 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571)272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sheeba Ahmed
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September 29, 2004